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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/840,043	05/07/2004	Chang Hao Chen	C2P4007-93-032E	8870
7590	09/16/2005		EXAMINER	
Chang Hao Chen 235 Chung - Ho Box 8-24 Taipei, TAIWAN			MAY, ROBERT J	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/840,043

Applicant(s)

CHEN ET AL.

Examiner

Robert May

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification must describe the filling of the "via hole" with the same material as the material of the transparent plug as claimed in Claim 12.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the via hole filled with the material same as the transparent plug as claimed in Claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because the reference character 52 as shown in Figure 5 is not mentioned in the description.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

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and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1,4-5, 7, & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao (US Pat 5,980,077).

In regard to Claims 1,4-5, & 7, Shiao discloses in Fig. 2, an illuminated driving tool with a light emitting handle (10) having a receiving hole (23) where a mounting plug (31) made from a transparent light transmitting material having a hole in which is inserted a metal plate (32) which protrudes from one end of the transparent plug (31) which can be used as an opener and is shown to have flat end or a cruciform end (30). However, Shiao fails to explicitly disclose the mounting plug as being made from a hard plastic material. However, it would be obvious to one of ordinary skill in the art to fabricate the plug from a hard plastic because plastics are notorious for being easy to mold, light weight, and is inexpensive. Therefore, it would be obvious to use a clear hard plastic to fabricate the mounting plug of Shiao because plastics are notorious for being easy to mold, light weight, and is inexpensive.

In regard to Claim 12, Shiao does not disclose a material that is the same as the mounting plug (31) filling in the hole of the mounting plug (31). However, it would be generally obvious to one of ordinary skill in the art to fill in the hole or have a material occupy the same space as the hole because it would provide adhesive structural support for the tool that is inserted or for the transparent plug when no tool is inserted while still maintaining the light transmitting characteristic of the plug. Therefore, it would be obvious to one of ordinary skill in the art to modify the illuminating tool of Shiao by inserting or filling the hole of the mounting plug (31) with the same material as the

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mounting plug (31) so that it secures the tool to the plug or maintains the structural integrity of the plug when no tool is used while still maintain the light transmitting property of the mounting plug (31).

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao as applied to claims 1,4-5, & 7 above, and further in view of Lo (US Pat 6,231,204).

In regard to Claim 2, Shiao teaches and suggests all of the elements of Claim 1, but fails to explicitly disclose a light emitting diode as the light source. However, Lo discloses an illuminated optic pen where the light source may be an LED or a laser module (21) (Col 2, Lines 14-15). It is generally know to one of ordinary skill that LEDs are compact and energy efficient light sources, which are optimal for small electronic devices.

In regard to Claim 3, Shiao teaches and suggests all of the elements of Claim 1, but fails to explicitly disclose a laser as the light source. However, Lo discloses an illuminated optic pen where the light source may be a laser module (21) (Col 2, Lines 14-15). It is generally know to one of ordinary skill in the art that using a laser on a small hand held device will enable the device to be used as a laser pointer, therefore it would be obvious to one of ordinary skill in the art to modify the light source of Shiao with the laser module of Lo so that the device can be used as a pointer.

Claims 6 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao as applied to claims 1,4-5, & 7 above, and further in view of Nakagawa (US Pat 4,996,976). Shiao teaches and suggests all of the elements of Claims 1 & 7, but fails to teach a light emitting device where the transparent plug is mixed with fluorescent material or source. However, Nakagawa discloses a tongue depressor with an illuminating means where optical fibers made from a fluorescent grade material (Col 3, Line 1) run the length of the tongue depressing blade (2) so as to allow the entire length of the fibers (7) to glow and illuminate one's throat. It is well know to one of ordinary skill that a fluorescent grade material notorious for distinctively glowing when exposed to an ultraviolet light. Therefore, it would be obvious to modify the transparent plug of Shiao with the fluorescent type of material of Nakagawa because it would allow the transparent plug to distinctively glow.

Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao as applied to claims 1,4-5, & 7 above, and further in view of Browning (US Pat 4,016,414). Shiao teaches and suggests all of the elements of Claim 1, but fails to explicitly teach an illuminated tool with and insertable pencil or pen tip. However, Browning discloses a writing device incorporating an illuminating means where a transparent barrel is suitable to receive a pencil or an ink cartridge (Col 3, Lines 30-33). This allows the tool to be used as a writing utensil while illuminating the area where to be written on in a dark environment. Therefore, it would be obvious to one of ordinary skill in the art to modify the illuminating tool of Shiao with the insertable ink cartridge or

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pencil of Browning so that the illuminating tool can be used as a writing instrument in a dark environment.

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiao as applied to Claim 1 above, and further in view of Lai (US Pat 6,196,695). Shiao teaches and suggests all of the elements of Claim 1, but fails to explicitly teach a telescopic tube installed in the via hole wherein a magnet is installed at the front end of the telescopic tube. However, Lai discloses in Fig. 3 a transformable screwdriver with an illuminating means where a telescoping member (24) with a magnet at the front end of rod so that it can extend to length enabling access within small holes or orifices and the magnet helps to keep the tool bit (screwdriver bit) in place or attract bits or metallic objects (Col 2, Lines 55-56). Therefore, it would be obvious to one of ordinary skill in the art to modify the illuminating tool of Shiao with the telescoping magnet element of Lai in order to keep the tool bit in place or attract metallic objects in hard to reach areas such as small holes or orifices.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Thomson (2,336,136), Wood (2,813,968), Nevin (5,826,969), & Chen (6,478,442) disclose an illuminating screwdriver. Gorman (5,967,638) discloses an illuminating diving rod with phosphor coated tube enabling a fluorescent effect.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert May whose telephone number is (571) 272-5919. The examiner can normally be reached between 9 am– 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval PAIR system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sandra O'Shea
Supervisory Patent Examiner
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